

3-4-8 #13

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: Hsu

Serial No.: 09/965,145

Filed: September 27, 2001

For: Method and System for Producing
Dynamically Determined Drop Shadows
in a Three-Dimensional Graphical User
Interface

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Group Art Unit.: 2671

Examiner: Arnold Adam

Attorney Docket No.: AUS920010508US1

Office of Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

35525
PATENT TRADEMARK
OFFICE CUSTOMER

RENEWED PETITION UNDER 37 CFR 1.137(b)

A letter of Dismissal of a Petition to Revive for the above-application was received by
Applicant stating:

“the Commissioner may require additional information where there is a question
whether the delay was unintentional.”

Attached is a copy of the Office of Petitions letter of Dismissal of the Petition to Revive as
well as a copy of the Petition for Revival of an Application filed on March 15, 2007 indicating the
issue fee and petition fees were submitted.

Per the attached Declaration, Applicant was unaware that the previous outside counsel was not attending to the matter payment of the Issue Fee.

In consideration of these submissions, Applicant respectfully requests that the Petition to Revive filed on March 15, 2007, be reconsidered.

No fee is believed to be required. If, however, any fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0447. A four month extension of time is believed to be necessary. The extension is requested, and I authorize the Commissioner to charge fees for this extension to IBM Corporation Deposit Account No. 09-0447.

Respectfully submitted,

/Duke W. Yee/ 

Duke W. Yee
Reg. No. 34,285
Yee & Associates, P.C.
PO Box 802333
Dallas, TX 75380
972/385-8777
Attorney for Applicant



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

IBM CORPORATION
INTELLECTUAL PROPERTY LAW
11400 BURNET ROAD
AUSTIN TX 78758

COPY MAILED

SEP 05 2007

In re Application of
Jimmy Ming-Der Hsu
Application No. 09/965,145
Filed: September 27, 2001
Attorney Docket No. AUS920010508US1

OFFICE OF PETITIONS
DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(b) filed March 15, 2007, requesting revival of the above-identified application.

The petition is dismissed.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time (and fee) under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)."

This application became abandoned for failure to timely pay the issue and publication fee on or before November 24, 2004, in reply to the Notice of Allowance mailed August 24, 2004. A Notice of Abandonment was mailed on January 13, 2004.

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by: (1) the required reply (unless previously filed), which may met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute, but must be the payment of the issue fee or any outstanding balance thereof in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof; (2) the petition fee required by 37 CFR 1.17(m); (3) an adequate statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) in some instances, a terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)). This petition lacks item (4) above.

35 U.S.C. § 41(a)(7) authorizes the Commissioner to accept a petition "for the revival of an unintentionally abandoned application for a patent." As amended December 1, 1997, 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where

Application No. 09/965,145

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there is a question whether the delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). See In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989). Here in view of the inordinate delay in the attempt to resume prosecution, there is a question whether the entire delay was unintentional. Petitioner should note that the issue is not whether some of the delay was unintentional by any party; rather, the issue is whether the entire delay has been shown to the satisfaction of the Director to be unintentional.

The language of both 35 USC 41(a)(7) and 37 CFR 1.137(b) are clear and unambiguous, and furthermore, without qualification. That is, the delay in filing the reply during prosecution, as well as in filing the petition seeking revival, must have been, without qualification, "unintentional" for the reply to now be accepted on petition. The Office requires that the entire delay be at least unintentional as a prerequisite to revival of an abandoned application to prevent abuse and injury to the public. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.A.N. 771 ("[i]n order to prevent abuse and injury to the public the Commissioner . . . could require applicants to act promptly after becoming aware of the abandonment"). The December 1997 change to 37 CFR 1.137 did not create any new right to overcome an intentional delay in seeking revival, or in renewing an attempt at seeking revival, of an abandoned application. See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53160 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 87 (October 21, 1997); and clearly stated clear that any protracted delay could trigger, as here, a request for additional information. As the courts have since made clear, a protracted delay in seeking revival, as here, requires a detailed explanation that will excuse the delay as opposed to a general allegation. See Lawman Armor v. Simon, 2005 U.S. Dist. Lexis 10843, 74 USPQ2d 1633, at 1637-8 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005) at *21-*23.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Any renewed petition may be addressed as follows:

By mail:

**Mail Stop PETITIONS
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450**

By hand: Customer Service Window
Randolph Building 401 Dulany Street
Alexandria, VA 22314:

By fax: (571) 273-8300
ATTN: Office of Petitions

Application No. 09/965,145

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Inquiries related to this decision may be made to the undersigned at (571) 272-³²⁰⁸~~3247~~.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

cc:

IBM INTELLECTUAL PROPERTY LAW
11400 BURNET ROAD
AUSTIN, TX 78758

RECEIPT

PTO/SB/84 (07-06)

Approved for use through 09/30/2006. OMB 0851-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Docket Number (Optional)

AUS920010508US1

First named inventor: Hsu

Application No.: 09/965,145

Art Unit: 2871

Filed: 9/27/2001

Examiner: Lehner, W.

Title: METHOD AND SYSTEM FOR PRODUCING DYNAMICALLY DETERMINED DROP SHADOWS IN A THREE-DIMENSIONAL
GRAPHICAL USER INTERFACEAttention: Office of Petitions
Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
FAX (571) 273-8300

2007 MAR 16 PM 3:11

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus an extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

1. Petition fee☐ Small entity-fee \$ _____ (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.☒ Other than small entity - fee \$ 1500 (37 CFR 1.17(m))**2. Reply and/or fee**A. The reply and/or fee to the above-noted Office action in
the form of _____ (Identify type of reply):☐ has been filed previously on _____
☐ is enclosed herewith.B. The issue fee and publication fee (if applicable) of \$ 1700☐ has been paid previously on _____
☒ is enclosed herewith.

(Page 1 of 2)

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Docket Number (Optional)
AUS920010508US1

First named inventor: Hsu

Application No.: 09/965,145

Art Unit: 2671

Filed: 9/27/2001

Examiner: Lehner, W.

Title: METHOD AND SYSTEM FOR PRODUCING DYNAMICALLY DETERMINED DROP SHADOWS IN A THREE-DIMENSIONAL
GRAPHICAL USER INTERFACE

Attention: Office of Petitions
Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
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Information at (571) 272-3282.

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action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration
date of the period set for reply in the office notice or action plus an extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications
filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

1. Petition fee

- ☐ Small entity-fee \$ _____ (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.
- ☒ Other than small entity - fee \$ 1500 (37 CFR 1.17(m))

2. Reply and/or fee

A. The reply and/or fee to the above-noted Office action in
the form of _____ (identify type of reply):

- ☐ has been filed previously on _____.
- ☐ is enclosed herewith.

B. The issue fee and publication fee (if applicable) of \$ 1700.

- ☐ has been paid previously on _____.
- ☒ is enclosed herewith.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the
USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to
complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any
comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer,
U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED
FORMS TO THIS ADDRESS. SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

3. Terminal disclaimer with disclaimer fee

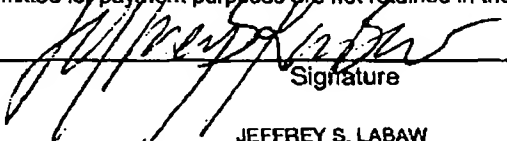
☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ _____ for a small entity or \$ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.


Signature

3/13/07
Date

JEFFREY S. LABAW
Typed or printed name

31,633
Registration Number, if applicable

IBM INTELLECTUAL PROPERTY LAW
Address

512-823-0494
Telephone Number

11400 BURNET RD., AUSTIN, TEXAS 78758
Address

Enclosures: ☒ Fee Payment

☐ Reply

☐ Terminal Disclaimer Form

☐ Additional sheets containing statements establishing unintentional delay

☒ Other: PETITION TO REVIVE - UNINTENTIONAL / Issue Fee

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

☐ Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

☐ Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office as (571) 273-8300.

Date

Signature

Typed or printed name of person signing certificate

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Hsu**

Serial No.: **09/965,145**

Filed: **September 27, 2001**

For: **Method and System for Producing
Dynamically Determined Drop Shadows in a
Three-Dimensional Graphical User
Interface**

§ Group Art Unit: **2671**

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§ Examiner: **Arnold Adam**

§
§ Attorney Docket No.: **AUS920010508US1**

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35525

PATENT TRADEMARK OFFICE
CUSTOMER NUMBER

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

DECLARATION UNDER 37 C.F.R. § 1.132

Sir:

No fees are believed to be required to file this Declaration. If, however, any fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0447. The Petition to Revive fee and Issue fee were submitted with a Petition to Revive on March 15, 2007.

In the Renewed Petition to Revive, please consider the following declaration.

DECLARATION UNDER 37 C.F.R. § 1.132

In support of the Renewed Petition to Revive in patent application number 09/965,145, I/We hereby declare the following:

- 1) I am of legal age and employed by International Business Machines Corporation (the "Assignee"), in which capacity I personally oversee Notices of Allowance requiring issue fees to be paid on behalf of the IBM Corporation.
- 2) On the mailing date of the Notice of Allowance in question, August 24, 2004, I was employed full time by the Assignee and have no record of receipt of said Notice of Allowance because the correspondence address was that of the outside counsel.
- 3) IBM was unaware that the outside counsel handling this case was not attending to the matter. The customer number used by the outside counsel in question did not list us and we were unable to monitor activity in PAIR.
- 4) Upon learning of this situation, we immediately prepared a Customer Number Upload Spreadsheet to change the cases under control of outside counsel to our customer number, which was then submitted to the Patent Office on August 23, 2006, in which Serial No. 09/965,145 was included in this change.
- 5) For some reason, this particular case was never changed at the Patent Office and we were unable to view any of the information for this case in PAIR.

6) On February 27, 2007, we filed a Power to Inspect with our Washington Office who inspected the files and found that an Issue Fee had not been paid.

7) On March 14, 2007 we prepared a Petition to Revive and paid the Issue Fee.

I understand that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon. All statements made in this declaration of my own knowledge are true and all statements made on information and belief are believed to be true.

DATE: 3/4/2008

A handwritten signature in cursive script, appearing to read 'Martha Acosta', written in dark ink.

Martha Acosta